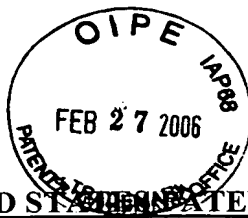DOCKET NO.: 239871US6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: GROUP: 2131

AKIYA SAITO, ET AL.

SERIAL NO: 10/614,036   EXAMINER: ABRISHAMKAR, KAVEH

FILED: JULY 8, 2003

FOR: DATA RECORDING MEDIUM, PROGRAM STARTING METHOD, AND
             PROGRAM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
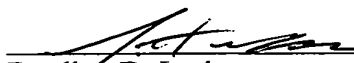Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No
amendments are being filed with this request.

The review is requested for the reasons stated on the attached sheets. No more than five
(5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
AKIYA SAITO, ET AL.	: EXAMINER: ABRISHAMKAR, KAVEH
SERIAL NO: 10/614,036	:
FILED: JULY 8, 2003	: GROUP ART UNIT: 2131
FOR: DATA RECORDING MEDIUM, PROGRAM STARTING METHOD, AND PROGRAM	:

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

In the October 27, 2005 Office Action, Claims 3-4, 6, 9 and 11-15 were rejected under 35 U.S.C. §102(e) as anticipated by Cok (U.S. Patent No. 6,865,550). Claim 10 was rejected under 35 U.S.C. §103(a) as unpatentable over Cok.

The January 31, 2006 Advisory Action indicated that the Request for Reconsideration filed December 9, 2005 was considered but did not place the application in condition for allowance.

In response to the rejection of Claims 3-4, 6, 9 and 11-15 under 35 U.S.C. §102(e), Applicants respectfully request review of this rejection, as next discussed.

Briefly summarizing, Applicants' Claim 3 relates to a data recording medium, including a medium identification information unique to the data recording medium recorded on the data recording medium. The data recording medium further includes:

> *a plurality of programs* recorded on the data recording medium, wherein the medium identification information includes *information with which one of the plurality of programs is designated*; and *a starting program*, recorded on the data recording medium, *configured to cause the program* designated with the medium identification information *to automatically start.*

Applicants respectfully submit that Cok fails to teach or suggest a starting program, recorded on the data recording medium, *configured to cause a program of the plurality of programs, designated by the medium identification information, to automatically execute.* The October 27, 2005 Office Action asserts that Cok discloses a feature regarding the claimed starting program and points out to Cok at column 5, lines 40-45 and lines 49-53.[1] In this passage, Cok teaches that "digital data can contain instructions or a transferred program 56 (FIG. 2) for matching the identifiers."[2] Cok further recites "the program *can be instructed* to allow direct access to the data" (emphasis added) and explains that another program may access the data stored on the optical medium without using the program 56.

Cok does not disclose or suggest a starting program which automatically executes a program of a plurality of programs based on identification information.[3] Cok merely allows another device or program to access data recorded to a disc. As explained by Cok at column 5, lines 39-58, the instructions in form of a program 56 can be used to verify the identifiers or can be used to suppress or mask data formats. Cok further explains that digital data includes unique identifiers so as to control the access to data by using these identifiers.[4] Executing a

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[1] See the outstanding Office Action at page 2, lines 12-18.
[2] See Cok at column 5, lines 39-41.
[3] See Cok at column 4, lines 51-57.
[4] See Cok, for example in the Abstract, and in Figure 1.

program is not accessing data. Accordingly, Cok merely describes instruction code on an

optical medium for matching identifiers.[5]

The January 31, 2006 Advisory Action states that Cok has "a medium which contains

'instructions or transferred program for matching the identifiers' (column 5 lines 38-43).

This is viewed as the 'starting program' since once the identifiers are matched, a program is

started."[6] Applicants respectfully disagree, since Cok does not teach or suggest such a

feature, as explained above. Applicants submit that the January 31, 2006 Advisory Action is

believed to use improper hindsight by rejecting Applicants' claims by constructing a solution

based on the teachings of Applicants' claims. See In re Lowry, 32 F.3d 1579, 32 USPQ2d

1031 (Fed. Cir. 1994) to recite "[t]o establish a prima facie case of obviousness, the burden of

establishing the absence of a novel, nonobvious functional relationship rested with the Patent

and Trademark Office," and "[t]he claimed invention involved an organization of information

and its interrelationships that the prior invention neither disclosed nor suggested."

Independent Claim 6 recites similar features in the context of a program starting

method, these features being analogous to the features recited in independent Claim 3, by

reciting "selectively executing a program *corresponding to the type that the medium*

identification information represents, the execution being actuated by a starting program

recorded on the recording medium" (emphasis added). Accordingly, for the reasons stated

above for the patentability of Claim 1, Applicants respectfully submit that the rejections of

Claim 6, and all associated dependent claims, are also believed to be overcome in view of

the arguments regarding independent Claim 1.

Therefore, the applied reference Cok fails to disclose or suggest every feature recited

in Applicants' claims, Applicants believe that Claims 3-4, 6, 9 and 11-15 are patentably

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[5] See Cok in Figure 1.
[6] See the January 31, 2006 Advisory Action on page 2, lines 4-6.

distinct over <u>Cok</u>, and therefore Applicants respectfully request review of the rejection based

on <u>Cok</u>.[7]

Based on the above-noted deficiencies in the outstanding rejections, Applicants

respectfully request that the rejections of Claims 3-4, 6, 9 and 11-15 be withdrawn or

properly supported.

<div align="right">
Respectfully submitted,

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[7] See MPEP 2131: "A claim is anticipated <u>only if each and every</u> element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."